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APPLICATION NO. 08/599,423	FILING DATE 01/16/96	FIRST NAMED INVENTOR SCHARF	ATTORNEY DOCKET NO. 2730R
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THE LUBRIZOL CORPORATION
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EXAMINER MCADY, E

ART UNIT 1111	PAPER NUMBER
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DATE MAILED: 03/06/97 ⁹

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/599,423

Applicant(s)

Scharf et al

Examiner

E. McAvoy

Group Art Unit
1111



☒ Responsive to communication(s) filed on Dec 12, 1996

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26

Of the above, claim(s) _____ is/are pending in the application.

☐ Claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-26 is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claims _____ is/are objected to.

_____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-26 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Tipton et al (4,594,378).

Applicant's arguments filed December 12, 1996 have been fully considered but they are not persuasive.

Applicants argue that Tipton does not define shear stability by any given test and argue that the instant claims are directed to compositions which provide a specific value in one of the most severe shear stability test, the taper bearing test. Applicants argue that they have discovered a balance of additives which provide good shear stability of the lubricating compositions. This is not deemed to be persuasive of patentability since the compositions may be the same. Applicants do not argue that the polymer components differ or that the fluidizing agent differs from Tipton, only that the compositions of the instant claims have a specific value in the taper bearing test, a test which is not discussed by Tipton. The Examiner is of the position that the compositions of the prior art inherently have the same shear stability.

Applicants also argue that Tipton does not teach or suggest the levels of additives in the instant claims. This is not deemed to be persuasive since Tipton teaches that component (A) may

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be present in an amount of about 0.1 to 20% by weight and that component (B) may be present in an amount of about 0.1 to 10% by weight. This totals up to 30% by weight of the polymer component which is clearly within the 15 to 40% by weight range cited in the instant claims. Mineral oil is clearly taught as a suitable base oil and low viscosity mineral oils are set forth in Examples D-F. The Examiner maintains the position that the compositions of the instant claims are taught by Tipton.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

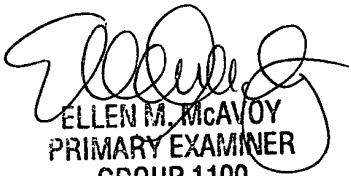
A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen McAvoy whose telephone number is (703) 308-2510.


ELLEN M. MCAVOY
PRIMARY EXAMINER
GROUP 1100

EMcAvoy

March 5, 1997